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| 09/811,970      | 03/19/2001  | Thomas Zermani       | MCA-508 US          | 9265             |

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EXAMINER

OCAMPO, MARIANNE S

| ART UNIT | PAPER NUMBER |
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1723

DATE MAILED: 05/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/811,970

Applicant(s)

ZERMANI ET AL.

Examiner

Marianne S. Ocampo

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 17-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 17-23 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 - 16, drawn to an apparatus/product being that of a filtration device, classified in class 210, subclass 486.
- II. Claims 17 - 23, drawn to a process of securing a filter within a filtration device, classified in class 264, subclass 678.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made by another and materially different process. In particular, the filter within a well can be secured to an inner wall thereof using a conventional fastener (a screw and bolt, clip means and the like) which would attach to a portion of the filter and screws the filter fixedly to the inner wall, or by welding (ultrasonically or other welding process) or by adhesively bonding the filter to the inner wall. Furthermore, the interlock on the inner wall of the well could be formed other than by skiving a portion of wall until it forms the interlock, the interlock could be a separate piece which could have been attached to the inner wall by ultrasonic welding or by

adhesive bonding, or by forming the well by injection or extrusion molding process with the interlock formed integrally therewith.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the search for one group is not necessary for the other group, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with John Hubbard on 5-6-02, a provisional election was made without traverse to prosecute the invention of group I, involving claims 1 – 16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17 – 23 are hereby withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Drawings***

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature is canceled from the claim(s):

a). the filtration device having more than one well, particularly with at least 96, 384 or 1536 wells, as in claim 16; and

b). the at least a portion of the inner wall that tapers outwardly as it progresses from the top toward the bottom section of the well, as in claims 5 – 6.

No new matter should be entered.

7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 7, 10 and 13 - 14 are rejected under 35 U.S.C. 102(b) as being anticipated by DeSalvo (US 5,284,586).

10. With regards to claim 1, DeSalvo discloses a filtration device comprising at least one well, at least one piece of filter (20), a filter retention device within the depth of the well (12) and a mechanical interlock (defined by an annular wall within the well/bore of the body 12 and ring 26), wherein the interlock (26) is formed from at least a portion of an inner wall of the well (12) and remains attached to and a portion of the inner wall, as in fig. 4 and col. 2.

11. Concerning claim 7, DeSalvo discloses the retention device being selected from the group consisting of underdrains, shelves, rims, lattice supports, undercuts and combinations thereof, particularly in fig. 4, the retention device is an undercut or rim forming an inner shoulder within the bore of the well, as in fig. 4.

12. Regarding claim 10, DeSalvo also discloses the filter (20) being made from a material selected from the group consisting of glass, polymer, metal, paper and ceramic, in particular, that of metal (woven wire mesh), as in col. 2, lines 30 – 32.

13. With respect to claim 13, DeSalvo further discloses the interlock being one or more skives (in fig. 4, one skive 26 is shown), as in fig. 4 and col. 2.

14. With regards to claim 14, DeSalvo also discloses the interlock (26) being one or more skives formed continuously from a portion of the wall (12), as in col. 2 and fig. 4.

15. Claims 1 - 3, 7 - 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (US 5,695,639).

16. Regarding claim 1, Johnson discloses a filtration device (100) comprising at least one well (upper reservoir section, 1), at least one piece of filter (15), a filter retention device (14, 11, 2) within the depth of the well and a mechanical interlock (7, 8), wherein the interlock (7, 8) is formed from at least a portion of an inner wall (7) of the well (1, 3) and remains attached to and a portion of the inner wall (7), as in figs. 1 and 3 and in cols. 2 - 4.

17. With regards to claim 2, Johnson also discloses at least portion of the inner wall (7) being tapered inwardly as it progresses from the top of the well toward the bottom (near 14) of the well, as in figs. 1 and 3.

18. Concerning claim 3, Johnson further discloses at least a portion of the inner wall (7, 8) being tapered inwardly as it progresses from the top of the well toward the bottom (near 14) of

the well, wherein the taper (6) is from about 0 degrees toward a vertical center line of the well (1) to about 20 degrees toward the vertical center line of the well (1), as figs. 1 and 3.

19. With respect to claim 7, Johnson discloses the retention device (13, 14, 11) being selected from the group consisting of underdrains, shelves, rims, lattice supports, undercuts and combinations thereof, particularly in figs. 1 & 3, the retention device (13, 14) is an underdrain, lattice support or perforated shelf forming an inner shoulder within the bore of the well, as in figs. 1 – 3.

20. Regarding claim 8, Johnson further discloses the filter retention device (13, 14) being an underdrain, as in figs. 1 – 3.

21. With regards to claim 9, Johnson also discloses the filtration device (100) being a single molded plastic piece, as in fig. 3 and col. 2, lines 22 – 31, and the retention device (13, 14) being integrally formed therewith, as in fig. 3.

22. With respect to claim 10, Johnson also discloses the filter (15) being made from a material selected from the group consisting of glass, polymer, metal, paper and ceramic, in particular, that of natural and synthetic materials including paper, cellulosic resins, nylon, polyester and the like, as in col. 42, lines 43 – 46.



23. Concerning claim 11, Johnson further discloses the filter (15) being made from a polymeric material including nitrocellulose and cellulose acetate, which are among those materials recited in claim 11.

24. Regarding claim 12, Johnson also discloses the device being made of a thermoplastic (organic plastic) material such as polysulfone, which is an example of a thermoplastic polymer (i.e. polyolefin; for definitions of a *polyolefin*, see attached Hawley's Condensed Chemical Dictionary, page 903 and of *polysulfone*, page 906), as in col. 2, lines 29 – 31.

25. With regards to claim 15, Johnson discloses the mechanical interlock (7, 8) being one or more crimps (7, 8, i.e., a bent portion) formed continuously from a portion of the inner wall (7) of the well (1), as in figs. 1 and 3.

26. Claims 1 – 8, 10 and 15 are rejected under 35 U.S.C. 102 (b) as being anticipated by Callaghan (US 5,503,740).

27. Concerning claim 1, Callaghan discloses a filtration device (100) comprising at least one well (upper funnel/reservoir section, 20), at least one piece of filter (22), a filter retention device (21) within the depth of the well (20) and a mechanical interlock (32, 55), wherein the interlock (55, 32) is formed from at least a portion of an inner wall (24) of the well (20) and remains attached to and a portion of the inner wall (24), as in fig. 6 and in cols. 2 – 3.

28. With regards to claim 2, Callaghan also discloses at least portion (55) of the inner wall (24) being tapered inwardly as it progresses from the top of the well toward the bottom (adjacent the funnel portion 21 of the well), as in fig. 6.

29. Concerning claim 3, Callaghan further discloses at least a portion (55) of the inner wall (24) being tapered inwardly as it progresses from the top of the well toward the bottom of the well, wherein the taper is from about 0 degrees toward a vertical center line of the well (20) to about 20 degrees toward the vertical center line of the well (20), as fig. 6.

30. With respect to claim 4, Callaghan also discloses at least a portion (55) of the inner wall (24) being tapered inwardly as it progresses from the top of the well toward the bottom of the well, wherein the taper is about 7 degrees toward a vertical center line of the well (20), as in fig. 6.

31. Regarding claim 5, Callaghan also discloses at least a portion of the inner wall (24) being tapered outwardly (a flange extending opposite direction from the flange 55 at the bottom end of wall 32 and which sits in the groove in the support/funnel section 21 on the outer peripheries of the filter 22) as it progresses from the top of the well toward the bottom of the well, wherein the taper is from about 0 degrees toward a vertical center line of the well (20) to about -20 degrees toward the vertical center line of the well (20), as fig. 6.

32. Concerning claim 6, Callaghan also discloses at least a portion of the inner wall (24) being tapered outwardly (same flange in claim 5 above opposite the flange 55 and at the bottom end of the wall 32) as it progresses from the top of the well toward the bottom of the well, wherein the taper is about -7 degrees toward a vertical center line of the well (20), as in fig. 6.

33. With respect to claims 7 - 8, Callaghan discloses the retention device (21) being selected from the group consisting of underdrains, shelves, rims, lattice supports, undercuts and combinations thereof, particularly in fig. 6, the retention device (21) is an underdrain/lattice support.

34. With regards to claim 10, Callaghan discloses the filter (22) being made from paper, which is among those materials recited in claim 10, as in col. 1, lines 43 – 44 and in col. 2, lines 31 - 32.

35. Regarding claim 15, Callaghan further discloses the interlock (55, 32) being one or more crimps formed continuously from a portion of the wall (24) of the well (20), as in fig. 6.

***Claim Rejections - 35 USC § 103***

36. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

37. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson.

38. Concerning claim 16, Although Johnson fails to disclose the device having a number of wells selected from the group consisting of 96 (wells), 384 (wells) and 1536 (wells), it is considered obvious to one of ordinary skill in the art at the time of the invention to modify the filtration device by increasing the number of wells (thereby also increasing the number of filters therein) from one to a plural number including 96, 384 and 1536, as a matter of design choice of the manufacturer, as well as increase the ability to perform the filtration using the device. In other words, numerous and diverse types of fluids can be simultaneously filtered if the device of Johnson is modified to have more than one well. Furthermore, it has been established by case law, *In re Harza* [274 F.2d, 124 USPQ 378 (CCPA 1960)], that in the instance where a mere duplication of parts (in this instance, duplication of the number of wells of the filtration device from one to 96, 384 or 1536) for a multiplied effect does not carry any patentable weight or significance unless a new or unexpected result is produced. See also M.P.E.P. section 2144.04, part VI paragraph B.

### *Conclusion*

39. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 5,139,685 (de Castro et al.), 6,105,789 (Boast), and 5,288,300 (Muller et al.).

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne S. Ocampo whose telephone number is (703) 305-1039. The examiner can normally be reached on Mondays to Fridays from 8:00 A.M. to 4:30 P.M..

41. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (703) 308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

42. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

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M.S.O.

May 7, 2002

*M. Savage*  
**MATTHEW O. SAVAGE**  
**PRIMARY EXAMINER**